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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,960	09/28/2001	Michael F. Angelo	1662-40100 (P00-3336)	3303

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT PAPER NUMBER

2137

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,960

Applicant(s)

ANGELO ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-23,25-43 and 45-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-23,25-43 and 45-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1, 4-23, 25-43 and 45-64 are pending.
2. Amendment filed 09/13/2005 has been received and considered.

Claim Rejections - 35 USC § 112

3. The rejections under the second paragraph of 35 USC 112 have been withdrawn based on the filed amendments.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 10-11, 20-22, 40, 45-46, 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenichi (JP 08251660).

As per claims 1 and 40, Kenichi discloses generating a security message; (b) transmitting said security message to said portable electronic device; performing an action on said portable electronic device in response to said security message

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(see abstract, paragraphs 9 and 19), said action selected from a group consisting of causing a short circuit, placing the portable electronic device in a mode in which a function of the portable electronic device is disabled, operating memory at an incorrect clock rate, causing said portable electronic device to report its location, and precluding access to data stored in the portable electronic device (see paragraph 22 and abstract).

As per claims 4 and 45-46, Kenichi discloses the destructive action prevents the portable electronic device from transmitting or releasing information (see abstract and paragraph 22).

As per claims 10-11, Kenichi discloses (b) occurs after a request has been received to perform the destructive action wherein a person or entity is authorized to cause (b) to happen and (b) occurs after said requesting person or entity is verified (see paragraphs 18-20).

As per claims 20-22 and 48-50, Kenichi discloses permitting a specified number of tasks to be performed during a specified period of time and performing (c) after either said specified number of tasks have been performed and the specified time period has expired (see paragraphs 18-20).

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5-9, 12, 23-27, 35-39, 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenichi as applied to claims 1 and 40 above, and further in view of Menezes et al (Handbook of Applied Cryptography).

As per claims 5-7 and 41, Kenichi fails to disclose digitally signing and verifying the security message.

However, Menezes et al teaches such a digital signature (see pages 22-23).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Menezes et al's digital signature on the security message of Kenichi.

Motivation to do so would have been for authentication, authorization, and non-repudiation (see page 22).

As per claim 8, the modified Kenichi and Menezes system discloses encrypting the key (see page 552). At the time of the

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invention it would have been obvious to a person of ordinary skill in the art to encrypt the key. Motivation to do so would have been to secure stored keys (see page 552).

As per claim 9, the modified Kenichi and Menezes system discloses only that person or entity is capable of causing said encrypted key to be decrypted so as to be used to digitally sign the security message (see paragraphs 18-20 and pages 388-389 where Menezes requires a password to obtain access which in this case is access to the decryption).

As per claims 12 and 42-43, the modified Kenichi and Menezes system discloses encrypting and decrypting the security message (see page 12) where it would have been obvious at the time of the invention to a person of ordinary skill in the art to encrypt the security message to obtain confidentiality (see page 12).

As per claims 23, 25-27 and 35-39, the modified Kenichi and Menezes system discloses these claimed limitations as similarly applied to the above claims. Where claims 38 and 39 are well known properties of any device storing a decryption key and therefore Official notice is taken that it would have been obvious to a person of ordinary skill in the art for the portable electronic device to have the properties that the key

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cannot be overwritten and cannot be copied in order to protect the key.

8. Claims 13-17 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenichi and the modified Kenichi and Menezes as applied to claims 1 and 23 above, and further in view of Schneier et al (US 5956404).

As per claims 13-17 and 28-32, Kenichi alone or in combination with Menezes fails to disclose digitally signing the security message and including a unique value that changes each time and this unique value being various things.

However, Schneier et al teaches such a digital signature with unique value (see column 4 lines 11-26).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Schneier et al's digital signature with unique value to sign the security message of Kenichi and the modified Kenichi and Menezes et al systems.

Motivation to do so would have been to provide an audit trail (see column 3 lines 41-49).

9. Claims 18-19, 33-34, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenichi and the modified Kenichi and Menezes as applied to claims 1, 23 and 40 above, and further in view of Baweja et al (US 6874130).

As per claims 18, 33 and 51, Kenichi alone or in combination with Menezes fails to disclose permitting the destructive action to be aborted once the security message is received by the portable electronic device.

However, Baweja et al teaches the ability to abort a destructive action (see column 6 lines 10-15).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Baweja et al's method of aborting a destructive action in the system of Kenichi and Menezes.

Motivation to do so would have been to authorize the deletion of the files (see column 6 lines 10-15).

As per claims 19 and 34, the modified Kenichi, Menezes and Baweja system discloses the further limitation require a key (see Menezes pages 388-389 where the password is the key).

10. Claims 52, 59, 61, 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenichi as applied to claim 1 above, and further in view of Hakomori (US 6370402).

As per claims 52, 59, 61, and 64 Kenichi discloses generating a security message; (b) transmitting said security message to said portable electronic device; performing an action on said portable electronic device in response to said security message (see abstract, paragraphs 9 and 19), said action

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selected from a group consisting of placing the portable electronic device in a mode in which a function of the portable electronic device is disabled, and precluding access to data stored in the portable electronic device (see paragraph 22 and abstract).

Kenichi fails to disclose the section being based on an identity of an entity that transmitted the message.

However, Hakomori teaches such a limitation (see column 3 lines 5-24).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to cause a selection based on the identity of an entity.

Motivation to do so would have been to allow the user to abort the destructive action (see column 3 lines 5-24).

11. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kenichi and Hakomori system as applied to claim 59 above, and further in view of Wang (US 5597751).

As per claim 60, the modified Kenichi and Hakomori system fails to disclose a short circuit.

However, Wang teaches a short circuit (see column 1 lines 43-57).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Wang's short circuit in the modified Kenichi and Hakomori system.

Motivation to do so would have been to destroy the function of the memory (see column 1 lines 43-57).

12. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kenichi and Hakomori system as applied to claim 59 above, and further in view of FOLDOC.

As per claim 62, the modified Kenichi and Hakomori system fails to disclose operating the memory at an incorrect rate.

However, FOLDOC teaches over clocking (see page 1).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use FOLDOC's method of over clocking in the modified Kenichi and Hakomori system.

Motivation to do so would have been to make the system stop working (see page 1).

13. Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kenichi and Hakomori system as applied to claim 59 above, and further in view of Lin (US 20010032236).

As per claim 63 Kenichi fails to disclose the security message causes said portable electronic device to report location information to the security station.

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However, Lin teaches transmitting a location to a station (see paragraph 131).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Lin's transmission of location information to the station of the modified Kenichi and Hakomori system.

Motivation to do so would have been to continuously know the location of the device (see paragraph 131).

14. Claims 53, 55, 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kenichi and Menezes system as applied to claim 23 above, and further in view of Hakomori.

The modified Kenichi and Menezes system disclose a CPU; a memory device coupled to said CPU; a decryption key stored in said memory device; wherein said CPU receives a security message and performs an action (see as applied above).

The modified Kenichi and Menezes system fails to disclose the section being based on an identity of an entity that transmitted the message.

However, Hakomori teaches such a limitation (see column 3 lines 5-24).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to cause a selection based on the identity of an entity.

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Motivation to do so would have been to allow the user to abort the destructive action (see column 3 lines 5-24).

15. Claims 54, 56, and 57 are similarly rejected over the modified Kenichi, Menezes, and Hakomori system as applied to claim 53 further in view of Wang, FOLDOC, and Lin respectfully, as above.

Response to Arguments

16. Applicant's arguments filed 09/13/2005 have been fully considered but they are not persuasive. Applicant argues: Kenichi fails to disclose the newly added limitations to, for example, claim 1; Examiner used the claimed invention as an instruction manual; Examiner used the motivation from Applicant's specification; and for a request to support the Official Notice taken.

With respect to Applicant's argument that Kenichi fails to disclose the new limitations, Kenichi discloses precluding access to data stored in the portable electronic device in paragraph 22.

With respect to Applicant's argument that Examiner used the claimed invention as an instruction manual it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as

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it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to Applicant's argument that Examiner used motivation from Applicant's specification, the motivation is given on page 22 of Menezes and therefore is not taken from Applicant's specification.

With respect to Applicant's request to support the Official Notice take, Schneier teaches to prevent a key from being copied on page 182 and teaches that overwriting a key will destroy it on page 185.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP